SOCIETY OF INTELLECTUAL PROPERTY ATTORNEYS
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Prof. Unnat P. Pandit

Controller General of Patents & Designs

The Patent Office

Mumbai

2nd January, 2023

Respected Sir,

Re.: Public Notices Issued by the Indian Patent Office dated December 26, 2022

FICPI-India is an organization representing the interest of the Intellectual Property Attorneys in Private Practice and comprises membership from almost all IP Attorneys firms in India. As your good office will appreciate, FICPI-India has all these years participated in and contributed to all major discussions/consultations with the IP India and DPIIT including in stakeholders meeting on various critical issues and represents the interest of a very crucial section of the stakeholders.

We write with reference to the three notices that were issued by your office on 26th December 2022. The members of FICPI-India are of the opinion that the said notices referenced herein-below not only put undue burden on the applicant but also compromise the quality of examination and patent grants. While FICPI India appreciates that the intention behind the issuance of such notices and the various steps taken by the IP Office towards making IP system better, we urge the Learned Controller General to reconsider the recent notices. It is submitted that should the above notices remain in effect, fair, proper and effective prosecution process, which is the core of the patent grant system, will be substantially compromised. It is respectfully requested that due cognizance of this request be taken before enforcing the notifications.

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The concerns of FICPI- India in relation to the said three notices issued by the IPO are presented hereafter :

1. **Public Notice No. 1:** Adjournment requests with reasonable cause and documentary evidence.
2. **Public Notice No. 2:** Hearing notice not more than 10 days; and
3. **Public Notice No. 3:** Appearances of authorized personnel before the Controller of Patents

PUBLIC NOTICE 1- ADJOURNMENT REQUESTS WITH REASONABLE CAUSE AND DOCUMENTARY EVIDENCE

1. Rule 129A of the Indian Patents Act permits the Applicant to take an adjournment (maximum two) of the hearing with *reasonable cause* along with the prescribed fee. The right to grant an adjournment is a discretionary power of the Controller. The applicant will likely include a reasonable cause in the request for adjournment which can be as simple as the Applicant requiring more time to prepare and review the matter for an effective hearing.

2. Having said this, an adjournment request must be filed at least three days before the hearing. This means that the Controller must review the request and inform the Applicant whether their request has been allowed or rejected. In case the request is disallowed, there may be a situation where the applicant may forfeit filing of a second adjournment request (read with the public notice 2).

3. Three days is a very narrow window period within which this communication will have to happen. If the Controller is of the opinion that the system or provisions of the Indian Patents Act (pre-grant oppositions/ serial pre-grant oppositions) are being abused, the Controller always has the power to reject the adjournment request

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4. Justifying reasonable cause with or without documentary evidence is an unreasonable requirement, which is not mandated by the Patent Rules and may lead to malpractices and introduce arbitrariness.

We respectfully submit that enforcing additional burden on the applicant/agent to collate evidence is not required and this notification may accordingly be withdrawn.

PUBLIC NOTICE 2: HEARING NOTICE PERIOD NOT MORE THAN 10 DAYS

1. The organization is happy to learn that the Patent Office is taking steps to clear the backlog and ensure that patents are timely granted so that the Applicant enjoys the benefit of patent rights in time. The delay will not be resolved by curtailing the hearing notice period. Curtailing the notice period to less than 10 days in view of Rule 129 is not only unreasonable but also ignores the fact that patent cases are complex matters that require extensive preparation.

2. The Controller's notice relies on Rule 129 of the Patents Rules, 2003 to justify the shortened period requiring attendance at the hearing. Rule 129 states as follows::

> *129. Before exercising any discretionary power under the Act or these rules which is likely to affect an applicant for a patent or a party to a proceeding adversely, the Controller shall give such applicant or party, a hearing, after giving him or them, ten days' notice of such hearing ordinarily.*

3. The most important word in the Rule quoted above is the last word "ordinarily". Considered with the fact that implementation of the entire rule is discretionary, the length of time afforded to an applicant when intimating the date for hearing must depend on whether the situation existing is ordinary or if there are extraordinary circumstances obtaining.

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4. The IPO annual report states that out of 58503 applications, about 58.42% are foreign filings. This means in all these cases, Indian Patent Agents would be dealing with foreign clients (mostly involving foreign law firms). The to-and-fro communication, discussion, and preparing effective arguments require sufficient time. A rushed approach to the last opportunity to present arguments, technical evidence and possible claim amendments will only lead to bad-quality prosecution and substantially jeopardize the rights of applicants.

5 (a). 10 days' notice will cause great hardship and will be considered unreasonable as the Controller has to be mindful that the Applicants are located in different jurisdictions and will require a global strategy for a given patent family. In fact, if a 10 days' notice is given, the patent agents in India **will effectively be given 3 working days** assuming that a notice is issued on Friday evening, 3 days to contact the foreign associate who will then contact their client, seek instructions from the Applicant and communicating the same to the Indian agent is an almost impossible task. If the Applicant requires more time to prepare for the hearing, an adjournment request has to be filed 3 days in advance of the hearing date.

5 (b). Further, hearing is the last chance given to the Applicant before final disposal of a matter. Hence, the time between the notice period and hearing date is very crucial as preparing documents, technical arguments, addressing pending objections etc within such very short duration is unfathomable. In several cases, the hearing notice is a verbatim copy of the examination report, a response of which was filed years ago. Ten days adjournment will render the objective of the provision infructuous and will be of no benefit to the Applicant. Also, imposing undue haste at final disposal stage of an application is contrary to the principles of Natural Justice in particular to the well established principal of *"audi alteram partem"* and may jeopardize the rights of Applicant.

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6. The abolition of IPAB has made IPO the last authority on applications fate before proceedings in any High Court begin (which are time-consuming as well as costly). This poses an additional responsibility on the Applicant, Patent Agents as well as the IPO likewise to handle each case with the utmost care, especially at such a crucial time in the lifecycle of the application.

7. Reducing the hearing notice period will not solve the real problem. The main concerns are the delays at the Patent Office end. For instance, there is a statutory obligation placed on the Controller by Rule 24C (12) which reads as follows:

> "*(12) the Controller shall dispose of the application within a period of three months form the date of receipt of the last reply to the first statement of objections or within a period of three months from the last date to put the application in order for grant under Section 21 of the Act, whichever is earlier:*
> *Provided that this shall not be applicable in case of pre-grant opposition*"

8. It is significant that such rule commences with the expression "Controller shall dispose". The words "shall dispose" has a final implication to it which is manifested in two possible situations. In the first, when the Controller completes their review of an "amended" application and finds satisfied that every requirement raised against the application has been met, and grants a patent thereon without further demur. The second situation is when the Controller completes their review but is not satisfied with the findings and offers the applicant the opportunity of an official hearing to present further submissions and/or revisions to overcome any remaining objections or meet any further requirements the Controller may have. Thus, the appointment of a hearing is not a formality. The purpose of appointing a hearing is to afford an applicant full and final opportunity to present the case for allowance of his application. Unfortunately, the build-up of patent applications awaiting disposal following the filing of a response to objections gives rise to significant delay, responsibility for which cannot be ascribed to any applicant or his attorneys since disposal is the duty of the Controller and his

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staff. Often hearings are appointed for months or even years after a response to the first examination report has been filed.

9. Similarly, in relation to pre grant opposition, the Rule 55(5) states as follows:

"*On consideration of the statement and evidence filed by the applicant, the representation including the statement and evidence filed by the opponent, submissions made by the parties, and after hearing the parties, if so requested, the Controller may either reject the representation or require the complete specification and other documents to be amended to his satisfaction before the patent is granted or refuse to grant a patent on the application, by passing a speaking order to simultaneously decide on the application and the representation ordinarily* ***within one month from the completion*** *of above proceedings*."

10. The Controller General is aware that in many instances, pending patent applications after the filing of response have been lying with the Patent Office for years and the terms of the said patent applications have come to an end with no fault of the applicant. The Applicant in view of the strict timelines would have timely filed a response to the first examination report and pursuant to a hearing under Sections 14 or 25, filed their written submissions. But for reasons unknown, some of these cases take months and years before final disposal. Additionally, in multiple cases, requests for examination have been filed and yet first examination reports have not been issued again with no fault of the applicant. This must be set in order. Having said that the Indian Patents in any event provides for several strict timelines and failure to comply with the same can lead to lapse of the right of the applicant such as:

a) Filing of national phase application within 31 months
b) Filing of request for examination within 48 months from the priority date
c) Filing of response to the first examination report within 6 months (extendible by 3 months)

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These in-built procedures already impose a huge burden on the Applicant to ensure compliances within the strict time frame provided by the Patent Act and Rules therefore further **curtailing the right of the Applicant who is entitled to a 30 days adjournment subject to payment of fee is unreasonable.**

11. Adjournment should not be seen as a biased weapon but **necessary** to allow an impartial and fair proceeding. Any abuse of process in isolated cases should not give rise to such blanket decisions which may adversely impact many stakeholders and applicants alike.

PUBLIC NOTICE 3: APPEARANCE OF AUTHORIZED PERSONNEL BEFORE THE CONTROLLER OF PATENTS

1. Any responsible firm of Indian patent attorneys will be fully aware of the statutory provisions of Section 123 (and 124) of the Patents Act, 1970. Under the provisions of the Indian Patents Act, only patent agents and advocates who have been authorized by the Applicant are permitted to appear before the Controller. The said authorization is provided by a power of attorney filed by the agent /law firm. Therefore, in any event, for hearings or any other proceedings before the Patent Office, agents or advocates who are not authorized through a power of attorney cannot appear or appear subject to filing of a power of attorney.

2. Furthermore, if the observation made by the Controller General in his notice is correct and it is ascertained that the unregistered or unauthorized person is a member of the staff of a particular firm of patent attorneys, an appropriate communication pointing out the transgression should be addressed by the Controller directly to the firm in question. Further, if something of this nature comes to the notice of the Controller in question before whom the unregistered person appears, the Controller has every right to refuse the deal with the said person.

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3. To streamline the process, at least in relation to hearings under the provisions of the Indian Patents Act, it is recommended that in the VC module, in addition to providing the name of the agent/ advocate appearing and their email id, the module is modified to include their agent number or bar council registration number with a confirmation that a POA has been filed or is on record.

4. In so far as Advocates appearing before the Controller are concerned, as long as a power of attorney is on record, there is no requirement under the law (Section 132 (b) Of Patents Act or otherwise for the said Advocate to also be accompanied with the Applicant or party concerned.

5. Follow-up with the administrative members of the Patent Office is necessary. It is not always possible for authorized patent agents/ advocates to engage with the Patent Office or staffs thereof. Such follow ups can include glitches in the e-filing module, updating of the electronic filing module for payment of fee, uploading of documents, correcting the status of a case on the patent office website for further processing, checking status of certified copies, status of review petitions, status of foreign filing licenses and many more. Therefore, a **Central System for all four jurisdictions (email and phone)** should be created in order to ensure streamlining of the communication **(2 way communication)** process with the Indian Patent Office.

We would be happy if the Patent Office can schedule meeting for a discussion on these issues.

Wishing the Patent Office family, a very Happy New Year!

Yours sincerely,

Archana Shanker
President, FICPI-India

Swarup Kumar
Secretary, FICPI-India