JAPAN INTELLECTUAL PROPERTY ASSOCIATION

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March 19 2008

To: Mr. V Ravi
Controller General of Patents, Designs, and Trade Marks,
The office of the CGPDTM
S M Road, Antop Hills,
Mumbai, 400037
India

Dear Mr. V Ravi,

The Japan Intellectual Property Association (JIPA) is a non-governmental organization that was established in 1938, which represents users of intellectual property systems in Japan. Counting about 900 leading companies as members, the JIPA submits recommendations and proposals to the relevant authorities and organizations with regard to the establishment of intellectual property systems overseas and improvements in the implementation thereof.

Visiting to your office in January 2007 & May 2005, and CGPDTM members' coming to Tokyo in November 2007, we are very grateful to you for taking discussion time on India IP system.

As for recruiting public comments on "*DRAFT MANUAL OF PATENT PRACTICE AND PROCEDURE - PATENT OFFICE, INDIA (2008)*", we submit especially important issues for JIPA's membership companies.
Your deeply consideration on these matters will be appreciated.

Very truly yours,

(Taisuke KATO)
President
Japan Intellectual Property Association
ASAHI SEIMEI OTEMACHI BLDG.18F
6-1 Otemachi 2-chome
Chiyoda-ku Tokyo, 100-0004, JAPAN

JIPA Opinions on the MANUAL OF PATENT PRACTICE AND PROCEDURE (DRAFT)

Japan Intellectual Property Association

1. Adoption of "absolute novelty" system for public use in determining novelty

(Patent Act Section 2(1), MANUAL CHAPTER-Ⅲ 3.2 Novelty of Invention)

Section 2(1) of the Indian Patents Act stipulates that a "'new invention' means any invention or technology which has not been anticipated by publication in any document or used in the country or elsewhere in the world before the date of filing of patent application with complete specification, i.e., the subject matter has not fallen in public domain or that it does not form part of the state of the art."

On the other hand, Section 3.2.1of MANUAL CHAPTER-Ⅲ 3.2 Novelty of Invention states that "An invention is considered new (novel) if it has not been anticipated by publication in any document any where in the world or used in the country ・・・・. Compared with Section 2(1) of the Indian Patents Act, Section 3.2.1 of MANUAL has no mention of "or elsewhere in the world", therefore, it has discrepancy between both, the novelty standard of public use on the MANUAL is limited in India.

However, the world trend, including that in Japan, is moving towards a view in which novelty of invention is rejected in the country in question if the invention has already been publicly exploited in another country.

Therefore, we hope that the MANUAL will clearly state the adoption of absolute novelty as same as Section 2(l) of Patent Act, and that the Section 3.2.1 of MANUAL will state "used in the country or elsewhere in the world", for example.

Also, we hope that the statement "Prior public knowledge or public use in India " on Section 7.1.1 d) of MANUAL CHAPTER-Ⅶ OPPOSITION PROCEEEDINGS TO GRANT OF PATENT is amended to "Prior public knowledge or public use in India or elsewhere in the world", for example, so as to avoid discrepancy with Section 2 of Patent Act.

2. Adoption of "whole content approach" system in determining novelty

(MANUAL CHAPTER-Ⅲ 3.2 Novelty of Invention)

Section 3.2.2 of Manual describes that "Although the term 'state of the art' has not been defined under the Patents Act, the following general principles are applied by the Patent Office to determine the novelty of the invention during the examination procedure by applying provisions of section 13 read with the provisions of sections 29 to 34:

An invention is not considered to be novel

(a) ・・・

(b) ...

(c) if it has been claimed in any claim of any other complete specification filed in India, which was filed before the date of application though published after the date of that application.."

However, the invention described in any other complete specification and drawing, not only any claims, filed in India which is filed before the application but published after said application is published. Accordingly, same invention as said invention described in any other complete specification filed in India, which is filed by the third party before the application, is one of prior art as well as any claims, therefore, should not be patented.

Furthermore, Japan, USA and EPO etc. almost countries adapt such kind of novelty system as the world trend.

Therefore, we hope that an invention shall not be considered to be novel if it has been described in **any claim, description and drawing** of any other complete specification filed in India which is filed by the third party before the application but published after said application (whole content approach system). For example, we hope that (c) of Section 3.2.2 is amended that " (c) if it has been disclosed of any other complete specification filed in India, which was filed before the date of application though published after the date of that application".

3. Protection of computer programs

(Section 3 of the Patents Act, MANUAL CHAPTER-IV Invention not patentable 4.11)

At present, Section 3, clause (k) of the Indian Patents Act stipulates that "a computer programme per se," etc. shall not be an invention. This clause was modified in 2004 by the Patents (Amendment) Ordinance, 2004 to "a computer programme per se other than its technical application to industry or a combination with hardware." However, the Patents (Amendment) Ordinance, 2004 was nullified along with the 2005 amendment, and the said clause was restored to that which was effective in 2003.

However, we consider that India should provide equal protection accorded in other countries in line with the purpose of paragraph 1 of Article 27 of the TRIPS Agreement, which stipulates that "any inventions, whether products or processes, in all fields of technology" shall be patentable subject matter.

On the draft of Manual, it is stated that "An invention consisting of hardware along with software or computer program in order to perform the function of the hardware may be considered patentable e.g. embedded systems."(P74 4.11.8)

Therefore, we hope that the Manual clearly states that a patent application is not rejected by the statement of "software" or "computer program". Concretely, the invention disclosed at page 39-45 of the attaché document is patentable if the invention satisfies other patentable conditions

4. Early publication of mailbox applications

(Section 11A(7) of the Patents Act, MANUAL CHAPTER-VI 6.1 Publication of application)

The Patents Act stipulates that provisional protection (the applicant's privileges and rights under Section 11A(7)) shall be accrued after the relevant application is published (Section 11A(7) of the Patents Act). On the other hand, regarding mailbox applications, rights are accrued if applications are examined and registered on and after January 1, 2005 without being published (said section). Therefore, provisional protection (the privileges and rights) that arises through publication in the case of ordinary patent applications shall not be applied to mailbox applications.

Therefore, we hope that CHAPTER-VI of Manual clearly states that mailbox applications also will be published.

5. Review of the obligation to furnish statements on the working of the patented invention and the criminal penalty

(Section 146(2) of the Patents Act, MANUAL CHAPTER-XVIII 18.1 Working of Patented Invention)

(i) In India, every patentee and every licensee must furnish statements that duly verify the extent to which the patented invention has been worked on a commercial scale in India, in respect of every calendar year within three months of the end of each year (section 146(2) of the Patents Act; rule 131(1) and (2) of the Patents Rules).

However, it would be an excessive burden on the patentees to furnish such statements for all of the patented inventions that they are working on a commercial scale in India on an annual basis. Furthermore, the status of the working of the inventions may involve business secrets, so the patentees would often face difficulties in preparing the statements.

Therefore, we request that the obligation to furnish statements on the working of the patented invention be abolished or simplified.

If the working status needs to be reported as a material for determining whether or not to grant a compulsory license, it would be sufficient to require the patentee to furnish the statements only when an application has been filed for the granting of a compulsory license. Thus, we request that the possibility for shifting to this kind of system be also examined.

(ii) If a person refuses or fails to furnish the statements on the working of the patented invention, he/she may be fined up to 10 lakh rupees as a criminal penalty (section 122(1)(b) of the Patents Act). This provision imposes a criminal penalty not only when the patentee intentionally makes false statements, but also when *the patentee does not furnish the statements—which do not* directly have a large detrimental effect on the public. There are also provisions that correspond to

dual liability provisions (section 124 of the Patents Act).

We consider such a criminal penalty to be an excessively severe punishment for violation of the obligation to furnish statements on the working of the patented invention. Therefore, we request that the criminal penalty be abolished.

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Cr. No. 16117

メイン ユーザー

送信者： "Toshiyuki Hori" <hori@jipa.or.jp>
宛先： <tcj@nic.in>; "delhi patent office" <delhi-patent@nic.in>
送信日時： 2008年3月19日 13:48
添付： Comments on the DRAFT MANUAL OF PATENT PRACTICE AND PROCEDURE.pdf
件名： Re: On public opinions from JIPA

Dear Sir,

Thank you for your following advice.
We compiled our comments on DRAFT MANUAL OF PATENT PRACTICE AND PROCEDURE - PATENT OFFICE, INDIA (2008)

And we send this document to tcj@nic.in by email and Mr.V.Ravi by express air-mail.

Your attention and to and cooperation in this matter would be highly appreciated.

Regards,

Toshiyuki Hori
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Japan Intellectual Property Association
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----- Original Message -----
From: delhi patent office
To: Toshiyuki Hori
Sent: Tuesday, March 11, 2008 7:24 PM
Subject: Re: On public opinions

Sir,

I am directed to inform you that your valuable comments can be sent either through e-mail to respective patent office ids or to tcj@nic.in or any other mode .

Anita,
Examiner of Patents & Designs.
Delhi patent office
----- Original Message -----
From: Toshiyuki Hori <hori@jipa.or.jp>
Date: Monday, March 10, 2008 1:13 pm

Subject: On public opinions
To: delhi-patent@nic.in

> Dear Sir,
>
> I would like to send a comments on DRAFT MANUAL OF PATENT
> PRACTICE AND
> PROCEDURE - PATENT OFFICE, INDIA (2008)
> from overseas.
>
> Can I send it via email? I hope so.
>
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> Thank you.
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