

# JAPAN INTELLECTUAL PROPERTY ASSOCIATION

ASAHI SEIMEI OTEMACHI BLDG.18F  
6-1 Otemachi 2-chome  
Chiyoda-ku Tokyo, 100-0004, JAPAN



TEL: 81 3 5205 3321  
FAX: 81 3 5205 3391  
URL: <http://www.jipa.or.jp/>

25th March, 2015

To: Shri Chaitanya Prasad  
Controller General of Patents, Designs & Trade Marks  
Bhoudhik Sampada Bhavan,  
Antop Hill, S.M. Road, Mumbai-400037,  
India

Dear Shri Chaitanya Prasad,

Re: The Draft Guidelines for Search and Examination of Patent Applications

The Japan Intellectual Property Association (JIPA) is a non-governmental organization that was established in 1938, which represents users of intellectual property systems. As an association having about 900 Japanese leading companies, 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.

In reference to "The Draft Guidelines for Search and Examination of Patent Applications" on which your office invites public comments on the website, enclosed please find JIPA's comments on the draft.

Your deeply consideration on these matters will be appreciated.

Yours faithfully

(Hirokazu Bessho)

Managing Director

Japan Intellectual Property Association

Asahi Seimei Otemachi Bldg.18F 6-1 Ohtemachi 2-chome,  
Chiyoda-ku Tokyo, 100-0004  
JAPAN

**Comments on the Indian Draft Guidelines  
for Search and Examination of Patent Applications**

Japan Intellectual Property Association

**Chapter 3**

**1. Patentability**

<Comments>

We disagree on the handling of the patentability of "Business Methods" etc., described in Section 3(k) of the guidelines and request to clarify the criteria for judging whether or not "Business Methods" etc are patentable.

<Reasons>

In particular, Section 3(k) from pages 51 to 52 described ""Business Methods" claimed in any form are not patentable subject matter." etc. We has no objection to the Indian Patent Act excluding business methods per se from patentability. However, it is going too far to regard every business method as not patentable.

We can understand the current draft shows that "Business Methods" claimed in any form are not patentable because the examiners cannot judge whether a patent application includes technical features or not.

As you may know, cloud services, for example, include a number of technical features. Such technical features should be protected by means of patents.

Accordingly, we request that the draft be corrected so as to grant even the patentability of "Business Methods" as long as their claims include technical features and also to clarify the criteria for determining whether or not the claimed inventions can be interpreted as "Business Methods" per se including no technical features.

In addition, we cannot agree that the computer programmes to run on a computer does not have patentability.

The recent electronic devices often become the innovative product by a superior computer programmes to run on a device than device in itself.

India retains a wealth of excellent IT technologies, and expanding the scope of protectable computer programs will be beneficial for protecting and enhancing IT technologies and IT-related industries in India.

Thus, various products are distributed in diverse forms in such a way that computer programmes are installed in the products after shipment of the

products.

The computer programmes themselves are also increasingly valuable. The draft should therefore be corrected so as to protect not only a computer programme stored in "a computer readable medium" but "a computer programme" as long as it satisfies predetermined conditions.

The Examination Guidelines in Japan provide for and explain both examples of claims of patentable inventions and those of claims of not patentable inventions, so as to make it easier for applicants to judge whether their inventions are patentable or not. In order to clarify the criteria for the "mathematical methods" and the "algorithms," as with the "business methods" and the "computer programmes" mentioned above, we request that the Indian guidelines should also provide for both illustrations.

Reference: Examination Guidelines for Patent and Utility Model in Japan Part VII Examination Guidelines for Inventions in Specific Fields Chapter 1 Computer Software-Related Inventions

[http://www.jpo.go.jp/cgi/linke.cgi?url=/tetuzuki\\_e/t\\_tokkyo\\_e/1312-002\\_e.htm](http://www.jpo.go.jp/cgi/linke.cgi?url=/tetuzuki_e/t_tokkyo_e/1312-002_e.htm)

## **2. Unity of invention**

<Comments>

We request that a patent application not be refused just because two or more independent claims are included in one application.

<Reasons>

The Indian Guidelines accept two or more independent claims per application. However, in practical settings, some patent applications, despite their satisfaction of the requirement for unity, receive a notice of reasons for refusal based on lack of unity of invention by the first examination report, just because two or more independent claims are included in one application. The filing of one application, rather than separate applications, for the items of an invention that satisfies the requirement for unity of invention is advantageous for the applicant in terms of procedures and cost and is also advantageous for examiners because the related items of the invention can be examined collectively and efficiently.

Hence, in cases where two or more independent claims are included in one application, we request that unity of invention be examined according to the Guidelines, instead of formally notifying the applicant of reasons for refusal based on lack of unity of invention.

## **Chapter 4**

### **3. Assignment of IPC codes**

<Comments>

We request accurate assignment of IPC codes, increase in the number of IPC codes assigned to patent publications, and updating of your IPC.

<Reasons>

Currently, five POs (Japan, USA, Europe, China, and South Korea) are reviewing the patent classification for the purpose of efficiently searching and examining patent applications that are increasing yearly. This means that the patent classification serves as a very useful tool in searching a vast number of patents. For the patent classification to serve as a useful tool, a plurality of IPC codes first needs to be accurately assigned to a patent publication from multiple perspectives. In view of Indian patents, some errors are found in the assignment of IPC codes. We request both accurate assignment of IPC codes to prevent such errors and the correction of incorrectly assigned IPC codes.

Also, we request the government of India to sign the Strasbourg Agreement Concerning the International Patent Classification in order to improve the accuracy of IPC. We consider that becoming a contracting state makes it easy to update your IPC to the latest edition of IPC in conjunction with MCD (Master Classification Database) managed by EPO.

### **4. Diversification of examples of IPC classification**

<Comments>

We request that examples and fields of IPC classification described in the Indian Guidelines be increased.

<Reasons>

Five examples of IPC classification are described in the Guidelines, and three of them are related to A61K31. Since there already exist the guidelines for examination of patent applications in the field of pharmaceuticals, we would appreciate your consideration of the addition of examples about sections other than Section A, for example.

## **Chapter 5**

### **5. Countries from which documents are to be searched**

<Comments>

We request that not only documents within India but documents from



other countries be searched.

<Reasons>

The Indian system mandates that novelty and inventive step be determined on the basis of any information being public in the world. At the present moment, there is more abundant prior literature based on US or European applications than on Indian applications. Thus, it is more likely that prior literature is retrieved from the documents from such countries. For these reasons, we request that not only documents within India but documents from other countries be actively searched.

An applicant who files applications for the same invention in India and other countries provides information under Article 8. It is desirable that such provided documents be referred to not only for examination but for search.

## **6. Contents of operators listed and search examples**

<Comments>

We request improvement in the contents of operators listed and the search examples described in the Indian Guidelines.

<Reasons>

Although commands used to designate fields for keyword search, for example, are illustrated as operators, these commands generally differ in mode depending on the database. We propose that the name of the database introduced in the Guidelines be described for reference. Furthermore, it seems that a different database is employed only in Search Example 2 among the search examples described in the Guidelines. If two or more databases are used in the patent office, it can be a good idea to list them as recommended databases.

As for date-based search refining in the search examples, it might be better if the Guidelines mention that as a precondition for search, this date refers to the date of filing or the priority date.

Search Example 4 introduces a search strategy from a different perspective. This is beneficial in terms of a plurality of search methods on the same theme.

Not to split hairs, FI might be appropriate instead of the Japanese F terms introduced in contrast with CPC in the explanation of classification.

## **7. Improvement in precision and efficiency of search**

<Comments>

We request measures directed toward improvement in the precision

and efficiency of search for prior literature.

<Reasons>

Keywords in claims are used as they are, in the search examples described in the Indian Guidelines. It is therefore expected that search keywords are determined in consideration of synonyms and terms of superordinate and subordinate concepts without being limited to the terms described in claims. As for the synonyms, we recommend you to use dictionaries or to create PO's own database.

Through meetings with examiners who are joining training in Japan, we hear that the scope of examiners' service is very wide, resulting in sluggish pace of examination and increased backlogs. In Japan, the initial search is carried out not by examiners but by specialists. We recommend the Indian system to use other resources as well in order to reduce burdens on the examiners.

The search efficiency also depends on the database used. In Japan, dedicated terminals that help examiners to easily find documents have been developed. It is expected that an IT-driven system that reduces burdens on the examiners is introduced to the Indian patent system.

The search may further depend on individual capacity. We recommend the Indian PO to train its personnel for developing their abilities to conduct search and share search know-how among them. We also recommend the Indian system to actively adopt the ways of other countries through interactions with their foreign examiners.

## **8. Search for determining inventive step**

<Comments>

We request that search procedures for determining inventive step be described in the Indian Guidelines.

<Reasons>

The draft merely states novelty search procedures. Patent applications are refused much more frequently for the reason of refusal of lack of inventive step than for the reason of refusal of lack of novelty. The Guidelines should describe search examples for cases where claimed elements are divided in order to determine inventive step. It concerns us that with the examples described in the current draft alone, only prior literature for determining novelty will be searched for.

## **Chapter 7**

### **9. Definite criteria for amendment**

<Comments>

We request that criteria for amendment be stated more clearly.

<Reasons>

In the case of "patent no. 133689 Orissa Cement (applicant) VS Belpahar Refractories (opponent)" on page 73, the Guidelines recite "(i) the amended claims cover matter disclosed "in substance" in the original specification, whether or not originally claimed; and." On the other hand, in the case of " OA/4/2009/PT/CH [189/2012] IPAB " on page 75, the Guidelines recite " None of these elements were claimed in the originally filed claims. Therefore such inclusions by way of amendments are not permissible under section59.." For these two cases, it seems that diametrically opposed explanations are given as to whether or not amended claims should satisfy "originally claimed" matters as requirements. The Guidelines should not introduce diametrically opposed views as examples.

## **Chapter 11**

### **10. Statements on the working of the patented invention**

<Comments>

We would respectfully like to request to abolish the requirement of the submission of statements on the working of the patented invention.

<Reasons>

It forces patentees, who have many patented inventions, to bear an excessive burden to prepare a statement on the working of patented inventions every year by confirming the status of working and to take the cost of representative firms to submit such statements. Especially, as an extreme example, the submission of a statement on the working of patented inventions is also required for the cases which have been abandoned in the applicable year. Consequently, we would respectfully like to request to abolish the submission of a statement on the working of such patented invention.

## **Chapter 12**

### **11. Timing of notification of post-grant opposition**

<Comments>

In the matter of post-grant opposition, we request the extension of the deadline for an advance notice of a date and time for the hearing of the

opposition (at least 10 days in advance) or a notice of relying on any publication not already mentioned (at least 5 days in advance).

<Reasons>

The period shown therein is too short for foreigners. Or otherwise, we request that the deadline be able to be extended in the cases in which foreigners are involved.

### **Annexure 1, Page 90, "Submission of priority document duly"**

#### **12. Introduce the Electronic Priority Document Exchange Method**

<Comments>

We would respectfully like to request to introduce the Electronic Priority Document Exchange by using the "WIPO Digital Document Access Service (DAS)".

<http://www.wipo.int/das/en/>

<Reasons>

The preparation of the priority document puts the administrative burden to applicants who have many applications filed in the IPO. The useful service enables to reduce the burden on applicants.

#### **13. The translation of priority document**

<Comments>

We would respectfully like to request that the Controller require applicants to submit the translation of priority document verified by affidavit only when the rejection is overcome by confirming the priority based on the translation of priority document as well as other Patent Offices (e.g. EPO, USPTO) .

<Reasons>

Act 138. (2) describes "...when required by the Controller", however, it appears that most of 1st Office Action describe "English translation of priority documents verified by applicants should be filed." as a fixed phrase regardless that the rejection is overcome by its submission. Consequently, we would respectfully like to request that it is required to submit the translation of priority document in order that the rejection is overcome by submitting the translation of priority document.

### **Others**

#### **14. General**

<Comments>





We request that examples introduced in the Indian Guidelines be enriched. We also request that cases of patent applications to be refused and to be granted a patent be both illustrated in the Indian Guidelines.

<Reasons>

Since the Guidelines disclose a very small number of examples, it is expected that it will be difficult for examiners and applicants to judge patentability in some cases. For these reasons, we request that this draft of the Indian Guidelines be modified so as to help examiners and applicants easily judge patentability on their own by increasing the number of examples. Examiners and applicants can better understand the Indian Guidelines by knowing both of the cases of patent applications to be refused and to be granted a patent.

The Examination Guidelines for Patents in Japan as found in the URL below satisfy these conditions and can therefore be referred to.

Reference: Examination Guidelines for Patents in Japan

[http://www.jpo.go.jp/tetuzuki\\_e/t\\_tokkyo\\_e/1312-002\\_e.htm](http://www.jpo.go.jp/tetuzuki_e/t_tokkyo_e/1312-002_e.htm)