

# JAPAN INTELLECTUAL PROPERTY ASSOCIATION

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28<sup>th</sup> December, 2018

To: Shri Sushil K Satpute  
Director, DIPP,  
Ministry of Commerce and Industry,  
Government of India  
Udyog Bhawan, New Delhi 110011  
India

## **Re: JIPA Comments on the Patents (Amendment) Rules, 2018**

Dear Shri Sushil K Sapute,

We, the Japan Intellectual Property Association “JIPA”, are a private user organization established in Japan in 1938 for the purpose of promoting intellectual property protection, with about 960 major Japanese companies as regular members.

Having learned the draft of the Patent (Amendment) Rules on your website, we would like to offer our opinions as follows.

### 1. Patent Rule 24C (Requirement for expedited examination)

We are very grateful for your proposal for this patent rule, an amendment rule, in which new clauses (c) to (f) are added to the Patents Rules as requirements for expedited examination to increase the number of applications which are subject to expedited examination. We expect that this amendment to the Patent Rules will promote operational improvements for expedited examination in your country.

However, we consider that the definition of the requirement for clause (f) is unclear, making it difficult to determine whether an application is subject to expedited examination. That is, according to clause (f), only national phase applications under PCT in India can also be interpreted as being subject to expedited examination. Accordingly, we are concerned that applications claiming priority under the Paris Convention might not be subject to expedited examination.

Through the Second Review Meeting on IP in August, 2018, JPO and the Department of Industrial Policy and Promotion, Ministry of Commerce and Industry of the Republic of India agreed in principle to start a bilateral Patent Prosecution Highway (PPH) program on a pilot basis in the first quarter of fiscal year 2019. Therefore, in order to provide more convenience

for Japanese applicants, who will file applications under PPH, we respectfully request that clause (f) should be corrected to clearly ensure that applications claiming priority based on Japanese applications under the Paris Convention are subject to expedited examination.

2. Patent Rule 55 (Pre-grant opposition to the patent)

We basically agree to this draft rule which allows the Patents Rules to clearly stipulate that a pre-grant opposition shall be processed by a bench.

However, for early settlement of an opposition, we propose that three members, not two members, should be involved in the opposition proceeding from the beginning thereof. According to the Draft Rules, only when two members differ in opinion, a third member shall be involved in the proceeding. From that point in time, the third member starts to process the opposition of interest (or consider the history of the proceeding carried out by the two members), which is thus thought to require an additional time period. We worry that this may go against the policy of your country that aims at early disposition. Therefore we consider that constituting a bench comprising three members from the beginning of the opposition proceeding allows early final disposition of the case.

In addition, in order to ensure the fairness of the decision on the opposition, we also respectfully request that the members of the bench should be nominated by a person other than the Controller who shall constitute the bench.

Your deeply consideration on these matters will be appreciated.

Yours faithfully



Osamu IKEMURA

Managing Director

Japan Intellectual Property Association