

# JAPAN INTELLECTUAL PROPERTY ASSOCIATION

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

## **Re: JIPA Comments on the Patents (Amendment) Rules, 2019**

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 980 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 21 (Requirement for filing of priority document)

Regarding this Patent Rule, we are very grateful for your proposal to amend the rule in order to clarify that the priority document for filing an application via the PCT route under PCT is required to be filed under Rule 51bis 1(e). We expect that this amendment to the Patent Rules will promote operational improvements where priority documents will be required to be filed in your country in line with the PCT Rules. In addition, we respectfully request that DPIIT should get such operational modifications across to the controllers or examiners of DPIIT as soon as possible in order to allow them to respond to the modifications.

In conjunction with the above, we respectfully request that the same operational requirements for priority documents as above be also applied to applications filed via the national route only when the validity of the priority claim is relevant to the determination of whether the invention concerned is patentable.

We consider that it would reduce the burden on applicants and also lighten the complexity during examination in your country to harmonize the requirement standard for priority documents between filing applications via the PCT route with and filing application via the national route.

In view of the above, we propose that the same amendment to Patent Rule 21 be made to, for example, Patent Rule 121.

## 2. Patent Rule 131, Form 27 (Statement regarding the working of patented invention)

The Draft Rules include amendments that reduce the burden on applicants such as deletion of some items described in Form 27 and permission to describe approximate value given to a product or the like by a patent, and we express our appreciation for DPIIT to make efforts to make such amendments.

Meanwhile, annual submission of the statement regarding the working of the patented invention is still a large burden in terms of the man-hours and costs for preparations such as research on matters to be described in the statement. In particular, such burdens are very large to patentees having a large number of patents. Therefore, we respectfully request further amendments to eliminate an obligation to furnish such a statement or to reduce the frequency of submission thereof.

In addition, recent years have witnessed a remarkable increase in the number of patents involved in a product, and some products may involve several thousands of patents. Therefore, correct calculation of value given to a product by each patent is impossible, and even approximate calculation of such value is difficult. Further, it is difficult to calculate such value even when the value is separated between a product and a process as indicated in the Draft Rules. Furthermore, whether or not each patent is worked in a product or what value is given to the product is a matter that a patentee wants to deal with as a trade secret, and making information of this kind public causes trouble for the patentee.

In addition, license information should also be dealt with inherently as a trade secret, and it is common practice to prescribe a duty of confidentiality in a license agreement. The draft amendment to Form 27 states that a licensee is also required to file a statement regarding the working of the patented invention. However, if a licensee files the statement, it may fall within the leakage of a trade secret or a breach of a license agreement.

It concerns us that the obligation to furnish a statement regarding the working of the patented invention based on Form 27 that has such problems to be solved may adversely affect business activities in your country.

Considering the above-described current situations, we respectfully request elimination of the obligation to furnish the statement or further simplification of the items to be described in the statement such as use of a checkbox to be only checked or unchecked to indicate whether or not the patented invention is worked. In addition, we respectfully request that the obligation for a licensee to furnish such a statement be abolished.

If it is difficult to eliminate the obligation or simplify the statement as described above, we strongly request that the above-mentioned trade secrets not be made public.

Your deeply consideration on these matters will be appreciated.

Yours faithfully

Munehisa Matsumoto

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Managing Director

Japan Intellectual Property Association